

VIA EFS

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:		:	:
Donna K. Lencki <i>et. al.</i> (Appellants)		:	:
		:	:
Conf. No.:	4094	:	Group Art Unit: 3626
		:	:
Appln. No.:	09/748,359	:	Examiner: Porter, Rachel L.
		:	:
Filing Date:	December 26, 2000	:	Attorney Docket No.: 051078-0020US
		:	:
Title:	SYSTEM AND METHOD FOR FACILITATING SELECTION OF BENEFITS		

**APPELLANTS' REPLY BRIEF TO EXAMINER ANSWER**

This Reply is filed in response to the Examiner's Answer mailed November 23, 2009. This Reply is being timely filed within two months of the mailing date of the Examiner's Answer.

The Director is hereby authorized to charge any fees due in connection with this submission to Deposit Account No. **50-0310** (Billing No. 051078-04-0020).

**I. STATUS OF CLAIMS**

The status of the claims is as follows:

Claims pending: 1-4, 6-12, 14-23, 25-31, 33-40, 42-48, 50-51, 70-73, 75-79, 81-82 and 106

Claims previously cancelled: 5, 13, 24, 32, 41, 49, 52-69, 74, 80, 83-105 and 107

Claims rejected: 1-4, 6-12, 14-23, 25-31, 33-40, 42-48, 50-51, 70-73, 75-79, 81-82 and 106

Claims objected to: None

Claims withdrawn from consideration but not cancelled: None

Claim allowed: None

The claims on appeal are 1-4, 6-12, 14-23, 25-31, 33-40, 42-48, 50-51, 70-73, 75-79, 81-82 and 106. A copy of the text of the claims involved in the appeal is attached as an appendix immediately following this Brief.

## **II. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

a. Whether claims 70-73, 75-79 and 81-82 are unpatentable under 35 U.S.C. § 112, second paragraph, on the grounds that the claims are indefinite;

b. Whether claims 1-4, 6-12, 15-17, 20-31, 34-36, 39-48, 51, 70-73, 75-79 and 82 are unpatentable under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,735,569 to Wizig (“Wizig”) in view of U.S. Patent No. 6,067,522 to Warady et. al. (“Warady”); and

c. Whether claims 14, 18-19, 33, 37-38, 50, 81 and 106 are unpatentable under 35 U.S.C. § 103(a) as being unpatentable over Wizig and Warady in view of U.S. Patent No. 5,890,129 to Spurgeon (“Spurgeon”).

### III. ARGUMENT

In addition to those arguments set forth in Appellants' Brief, the following arguments are made in response to the Examiner's Answer.

*Whether the rejection under 35 U.S.C. § 112, second paragraph, is improper:*

Claims 70-73, 75-79 and 81-82 stand rejected under 35 U.S.C. § 112, second paragraph, on the grounds that the claims are indefinite (Examiner's Answer, mailed November 23, 2009, section 9, items 1 and 2). Specifically, the Examiner asserts that while the preamble of claim 70 recites "a system", the body of the claim includes both system components and method steps. The Examiner further asserts that it is unclear to a potential infringer "whether the appellant is seeking protection for the system and its components/parts or for the method steps as performed by the system in this particular claim." (Examiner's Answer, mailed November 23, 2009, section 10(A)). Appellants submit that claim 70 appropriately claims a system with components that perform the recited functionality and not an apparatus and a method of using the apparatus, as referenced in the case law support cited by the Examiner. Thus, the manner in which such claim could be infringed is clear from the claim language (e.g., manufacture, use, sale/offer for sale of the system whose components perform the recited functionality). Still further, the Examiner asserts that the claim language recitation of a processor that receives a selection from an employee renders the claim unclear because the current claim language does not state how the processor is able to discriminate among users, as it does not recite any login or security features/functionality. (Examiner's Answer, mailed November 23, 2009, section 10(A)). Appellants submit that it is not aware of any requirement that the Appellants must state in the claim how and to what extent the processor is able to discriminate among users, nor does the Examiner cite to any. The claim language clearly recites that the source of the input to the processor is "an insurance coverage package selection from the employee."

Appellants respectfully request that the 112 rejection be withdrawn.

*Whether the rejections under 35 U.S.C. § 103(a) are improper:*

Claims 1-4, 6-12, 15-17, 20-31, 34-36, 39-48, 51, 70-73, 75-79 and 82 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,735,569 to Wizig ("Wizig") in view of U.S. Patent No. 6,067,522 to Warady et. al. ("Warady") (Non-Final Office

Action, dated March 5, 2009, sections 6 and 7) and claims 14, 18-19, 33, 37-38, 50, 81 and 106 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wizig and Warady in view of U.S. Patent No. 5,890,129 to Spurgeon (“Spurgeon”) ((Examiner’s Answer, mailed November 23, 2009, section 9, items 3, 4 and 5).

In its Appeal Brief, Appellants argued that each of the independent claims 1, 21, 40, 70, and 106 require “receiving an insurance coverage package selection from the employee, wherein the insurance coverage package . . . *automatically includes coverage under a plurality of benefit categories associated with the benefit type*”, which element was not disclosed in Wizig or Waraday. In response, the Examiner’s Answer states that such claims “do not recite language precluding the user from selecting particular benefits” and “Wizig allows the user to purchase (customized) healthcare insurance (benefit type) which is associated with a plurality of benefit types (i.e., inpatient hospital, pharmacy, emergency room, vision care). . . . In other words, appellant’s claimed invention does not define which benefits must be included to be ‘fully-functional.’” (Examiner’s Answer, mailed November 23, 2009, section 10(B)). Appellants respectfully disagree with this rationale. As the claim language makes clear, the “insurance coverage package” selected by the employee “automatically includes coverage under a plurality of benefit categories associated with the benefit type.” Regardless of which or how many benefit categories are included in the package, the claim requires that the “package” selected by the employee “automatically include[ ] coverage” for “a plurality of benefit categories”, which package can then be customized in accordance with the “line items” as discussed in more detail below. Wizig does not does not disclose receiving an insurance coverage package selection from an employee, wherein the insurance coverage package automatically includes coverage under a plurality of benefit categories associated with the benefit type, as required by the claims. Wizig discloses allowing an end user to build a panel of healthcare providers, which includes allowing the user to exclude coverage for a given type of physician. See, e.g., Figure 30 – 33 of Wizig. Such disclosure simply does not meet the required claim element.

In its Appeal Brief, Appellants further argued that each of the independent claims require “for each of the plurality of benefit categories automatically included in the package, simultaneously displaying a plurality of different line items associated with the benefit category to the employee on a user interface accessible through a computer network, wherein each of the

different line items displayed on the interface includes (i) an out-of-pocket cost parameter that corresponds to out-of-pocket costs paid by the employee for use of coverage provided under the benefit category and (ii) a corresponding benefit cost to the employee for purchasing the coverage under the benefit category” (hereinafter referred to as the “line item” element), which element is not disclosed in Wizig or Warady.

The Examiner’s Answer first infers that the line item element is not supported in the specification. (Examiner’s Answer, mailed November 23, 2009, section 10(C)). However, the line item element is clearly disclosed, at least, in Fig. 22C of the present application.

The Examiner’s Answer further asserts that Wizig does not disclose “a line item” as required by the claim, but this is disclosed in Warady. (Examiner’s Answer, mailed November 23, 2009, section 10(C)). In particular, the Examiner’s Answer disputes that Warady discloses a “take it or leave it” approach to plan selection as argued by Appellant. (Examiner’s Answer, mailed November 23, 2009, section 10(D)). Appellants respectfully disagree – Warady presents *pre-configured plans* to the employee (Warady, Figs. 7a – 7c), which the employee can accept or not. In contrast, the present invention does not merely present preconfigured plans to a consumer for election but, instead, allows a consumer to configure a plan herself by making selections from various options presented to her. The configurable nature of the claimed invention is reflected in the claim language, as set forth in detail in Appellants’ Appeal Brief.

The Examiner’s Answer further notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. (Examiner’s Answer, mailed November 23, 2009, section 10(D)). However, even in an obviousness rejection, all of the claim elements must be found in the prior art. In the present case, it is Appellants position that all of the claim elements are not found in the prior art and it has traversed the Examiner’s rejection on that basis.

The Examiner’s Answer further asserts that “the limitations regarding the data that are displayed on the screen are nonfunctional description material and are not functionally involved in the method steps recited [and, thus,] this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability.” (Examiner’s Answer, mailed November 23, 2009, section 10(F)). In particular, the Examiner’s Answer asserts that the display step

requires “displaying a plurality of line items . . .” and the next step requires “receiving . . . a purchase selection from the employee corresponding to one of the plurality of different line items” but, according to the Examiner, the receiving step “does not recite that the user is selecting the displayed information [and the] claim reader is to infer that the employee requires all the information recited in the specific detail found in the display step to make his/her decision/purchase selection.” The Appellants respectfully disagree. The claim clearly states that the purchase selection is received from the employee, which corresponds to one of the plurality of different “line items”, which term is clearly defined in the claim. It is not clear how the employee with make such a selection *without* the “line item” information being displayed, and the fact that the line item information is displayed “simultaneously” makes such selection process more efficient and meaningful.

In view of the foregoing, and the reasons set forth in Appellants’ Appeal Brief, Appellants respectfully submit that the cited references fail to disclose each and every element of each of the independent claims. Accordingly, withdrawal of the rejection is respectfully requested.

Conclusion:

In view of the foregoing, Appellants respectfully submit that the rejections made in the non-final Office Action dated March 5, 2009 are in error and therefore should be withdrawn.

Respectfully submitted,  
**MORGAN, LEWIS & BOCKIUS LLP**

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